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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85333926
Applicant	Caldera Pharmaceuticals, Inc.
Applied for Mark	MOLECULAR X-RAY FLUORESCENCE
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Applicant(s):Caldera Pharmaceuticals, Inc.	
Serial No.: 85333926	
Filed: Apr. 09, 2011	Law Office: 111
Mark: Molecular X-ray Fluorescence	
	Examining Attorney: Renee McCray

APPLICANT’S APPEAL BRIEF

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir:

Applicant has appealed the trademark examining attorney’s refusal to register the trademark “Molecular X-ray Fluorescence” for applicant’s class 9 goods (“downloadable scientific and medical data via the internet; Glassware for scientific experiments in laboratories; Plates, glass slides or chips having multiwell arrays that can be used in chemical analysis, biological analysis or patterning for scientific, laboratory or medical research use; Scientific apparatus and instruments for measuring relative DNA/RNA and protein and parts and fittings therefor; Scientific apparatus and instruments, namely, chromatography columns for use in purification in the laboratory and parts and fittings therefor; Scientific apparatus for use with membrane filtration, namely, water filter controllers and computer software for detecting and measuring water quality; Scientific apparatus, namely, spectrometers and parts and fittings therefor; Scientific apparatus, namely, spectrophotometer for measuring relative DNA/RNA and protein; Sensor chips

for scientific use.”), on the ground that applicant’s mark, for its class goods, is merely descriptive under the provisions of §2(e) of the Trademark Act, 15 U.S.C. §1052(e). The examining attorney has also stated that applicant’s “Molecular X-ray Fluorescence” mark cannot be amended to the supplemental register, because, according to the examining attorney, applicant’s “Molecular X-ray Fluorescence” mark, as applied to applicant’s class goods, is generic and incapable of functioning as a trademark for those goods.

Summary of Applicant’s position

Applicant respectfully submits

- a. The evidence of record does not support the examining attorney’s position that applicant’s “Molecular X-ray Fluorescence” mark is merely descriptive as to applicant’s class 9 goods, including the amended goods. In the final office action, it is stated that the expression “molecular x-ray fluorescence is a descriptive, and generic term for applicant’s goods and merely describes significant features. The examining attorney cites evidence obtained “from websites such as www.en.wikipedia.org, <http://prl.org/abstract> and <http://www.mendeley.com>” that purport to “show use of the term “molecular x-ray fluorescence” to name or describe a molecular imaging technique...”

The Basis of the Refusal

The final refusal to register, states as follows:

Applicant's proposed mark merely describes significant features, i.e., purpose and function, and application of use, of applicant's products, namely, that they are designed for use in connection with molecular x-ray fluorescence. Please see additional evidence obtained from Nexis and the Internet that consists of excerpted articles from websites such as www.en.wikipedia.org, <http://prl.org/abstract> and <http://www.mendeley.com> that show use of the term molecular x-ray fluorescence to name or describe a molecular imaging technique. Applicant's goods are used in connection with this technique. Accordingly, the mark is merely descriptive of the purpose and function of applicant's goods.

Thus, the examining attorney's position is primarily based on the proposition that the mark at issue in this appeal, "Molecular X-ray Fluorescence" is descriptive.

The Record and Evidence

The record primarily consists of the examining attorney's evidence seeking to demonstrate that the phrase "molecular x-ray fluorescence" is merely descriptive and generic as to applicant's class 9 goods, and applicant's evidence seeking to demonstrate that the expression "molecular x-ray fluorescence" is in fact not merely descriptive as to applicant's class 9 goods.

ARGUMENT

Applicant maintains that "Molecular X-ray Fluorescence" is not descriptive. In addition, applicant also reaffirms its arguments that the expression "molecular x-ray fluorescence," is not merely descriptive as applied to applicant's class 9 goods. The record submitted by the examining attorney consisted of a set of samples, none of which showed that "Molecular X-ray Fluorescence" was a widely used or meaningful term. Without any such evidence, there is simply no basis for the refusal to register.

As noted above, the examining attorney submitted a set of specimens into the record. Many of the specimens did not refer to any type of x-ray fluorescence at all, but instead contained various words from the list “molecular,” “x-ray,” and “fluorescence” distributed throughout the specimen. These references therefore cannot be considered as evidence that the phrase “molecular x-ray fluorescence” is a descriptive and/or generic term. These references should instead be considered as evidence that “molecular x-ray fluorescence” is in fact not a descriptive and/or generic term. There is absolutely no evidence anywhere in the record that would support the primary position of the examining attorney that “Molecular X-ray Fluorescence” is a widely used term. Without any such evidence, there is simply no basis for the refusal to register.

Specimen 1 submitted by the examining attorney is from the Journal of Nuclear Medicine, June 2011. It is excerpted below, with emphasis in the original. It should be noted that the words “molecular,” “X-ray,” and “fluorescence” do not relate to each other at all. As can be seen, this Specimen is not relevant to the proposed mark.

Part I (**molecular** imaging technologies) summarizes the different imaging techniques, with 18 chapters dealing with PET/CT, PET/MRI, SPECT/CT, micro **x-ray** CT, bioluminescent markers, optical imaging, **fluorescence** tomography, endomicroscopy, intravital microscopy, ultrasonography, and photoacoustic tomography. Part V (**molecular** imaging in drug evaluation) consists of 4 chapters dedicated to imaging in drug development and gene therapy, including clinical trials with PET and MRI.

Specimen 2 submitted by the examining attorney is from States News Service. The specimen contains each of the words “molecular,” “X-ray,” and “fluorescence,” but these words do not relate to each other at all. As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 3 submitted by the examining attorney is from benzinga.com. The specimen contains each of the words “molecular,” and “fluorescence,” but these words do not relate to each other at all. This specimen does not even contain the word “X-ray,” and clearly cannot relate to “molecular x-ray fluorescence.” As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 4 submitted by the examining attorney is from Biotech Equipment Update. The specimen contains each of the words “molecular,” “X-ray,” and “fluorescence,” but these words do not relate to each other at all. As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 5 submitted by the examining attorney is from Business Wire. The specimen contains each of the words “molecular,” “X-ray,” and “fluorescence,” but these words do not relate to each other at all, except for one instance where “molecular fluorescence” is used without reference to “x-ray.” As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 6 submitted by the examining attorney is from Bioscience Technology. The specimen contains each of the words “molecular,” “X-ray,” and “fluorescence,” but these words do not relate to each other at all, except for one instance where “fluorescence molecular” is used without reference to “x-ray.” As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 7 submitted by the examining attorney is from Wikipedia. The specimen describes “X-ray fluorescence,” but does not relate to the proposed mark “molecular x-ray fluorescence” at all. As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 8 submitted by the examining attorney is from Phys. Rev. Lett. The specimen contains the phrase “molecular X-ray fluorescence,” from a highly technical scientific paper from 1988. There is no evidence from this highly technical paper that the term “molecular x-ray fluorescence” is a widely known term.

Specimen 9 submitted by the examining attorney is from the Journal of Applied Physics, 1978. The specimen describes “X-ray fluorescence,” but does not mention the word “molecular” and does not relate to the proposed mark “molecular x-ray fluorescence” at all. As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 10 submitted by the examining attorney is from Biophysics Journal. This specimen describes “X-ray fluorescence,” and also has the word “molecular” in an unrelated context. It references Specimen 8. As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 11 submitted by the examining attorney appears to be the table of contents from the journal that contains specimen 8. Applicant believes that Specimen 11 and Specimen 8 are merely two pages from the same document.

Specimen 12 submitted by the examining attorney is from Spectroscopy Letters. The specimen contains the phrase “molecular X-ray fluorescence,” from a highly technical scientific paper from 1980. There is no evidence from this highly technical paper that the term “molecular x-ray fluorescence” is a widely known term.

Specimen 13 submitted by the examining attorney is from Review of Scientific Instruments. The specimen contains the phrase “molecular X-ray fluorescence,” from a

highly technical scientific paper from 1980. There is no evidence from this highly technical paper that the term “molecular x-ray fluorescence” is a widely known term.

Specimen 14 submitted by the examining attorney is from Spectrochemical Acta. This specimen does not appear to relate to the proposed mark at all. As can be seen, this Specimen is not relevant to the proposed mark.

Specimen 15 submitted by the examining attorney appears to be a citation from a database of the journal that contains specimen 8. This appears to be an automated index of papers, and should be considered merely a table of contents that references Specimen 8.

Specimen 16 submitted by the examining attorney appears to be a citation from a database of the journal that contains specimen 12. This appears to be an automated index of papers, and should be considered merely a table of contents that references Specimen 12.

The specimens submitted by the Examining Attorney in her office action of July 16, 2011, do not include the proposed mark “molecular x-ray fluorescence.” Applicant submits that these documents are irrelevant to Applicant’s proposed mark.

In the evidence submitted by the examining attorney, the most applicant can find is two (2) instances of the use of “molecular x-ray fluorescence.” in highly scientific papers, both dated in the 1980’s time frame. Those papers do not support the proposition that the phrase “molecular x-ray fluorescence”, as applied to applicant’s goods would be merely descriptive to any class of consumers to whom applicant’s goods would have been directed. Thus, the record does not support the proposition that the phrase is merely descriptive of applicant’s class 9 goods. Without any such evidence, there is simply no basis for the refusal to register.

Therefore, in contrast to the examining attorney's contention that:

Although, as applicant contends, x-ray fluorescence involves a process by which a substance is excited by the bombardment of x-rays, and there is a distinction between "atomic" and "molecular," the evidence of record clearly shows that molecular x-ray fluorescence is a molecular imaging technique that is used for molecular analysis is not supported on the record.

Finally, the examining attorney, in seeking to establish whether "molecular x-ray fluorescence" is suggestive or descriptive, states as follows.

A mark is suggestive if some imagination, thought or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005); TMEP §1209.01(a); *see In re Shutts*, 217 USPQ 363, 364 (TTAB 1983). Descriptiveness is considered in relation to the relevant goods and/or services. The fact that a term may have different meanings in other contexts is not controlling on the question of descriptiveness. *In re Chopper Indus.*, 222 USPQ 258, 259 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); TMEP §1209.03(e).

Although, as applicant contends, x-ray fluorescence involves a process by which a substance is excited by the bombardment of x-rays, and there is a distinction between "atomic" and "molecular," the evidence of record clearly shows that molecular x-ray fluorescence is a molecular imaging technique that is used for molecular analysis. There is nothing about the proposed mark that, when applied to applicant's goods, would require great contemplation or speculation as to their nature or purpose. Rather, the mark immediately and directly conveys that applicant's goods are designed for use in connection with molecular x-ray fluorescence. Thus, the mark is merely descriptive as applied to applicant's goods.

As shown by the uncontested evidence provided by the Applicant, "molecular x-ray fluorescence" is a meaningless phrase, because x-ray fluorescence is intrinsically not a

molecular process. Thus, applicant respectfully submits that the evidence also does not even establish how highly scientific individuals would react or how would consumers react upon learning of applicant's "Molecular X-ray Fluorescence" mark, and applicant further submits that even highly scientific individuals (including those who work with and sell products that perform, x-ray fluorescence, would not recognize the term "Molecular X-ray Fluorescence."

Caldera developed and used the mark "Molecular X-ray Fluorescence" that is at issue in this application, but this does not make it widely recognized. The applicant uses "Molecular X-ray Fluorescence" to promote our products, but it is not descriptive of our products or services. X-ray fluorescence instrument manufactures who appear to be the top experts in the field, do not use the term "Molecular X-ray Fluorescence" or the words "molecular" and "x-ray fluorescence" in sequence, and there is nothing in the record that suggests otherwise. This is because these terms are not descriptive of the process and Caldera merely coined the terms in order to have trademark protection for its products. In fact, granting trademarks for "Molecular X-ray Fluorescence" does not preclude the use of the term "x-ray fluorescence" to describe the products that are sold and used by others in the field. "Molecular X-ray Fluorescence" is not generic or descriptive and imagination must be used. Caldera itself applied for and was granted patents for novel "Molecular X-ray Fluorescence" products. It wishes to trademark "Molecular X-ray Fluorescence" to differentiate its products from other "x-ray fluorescence" products that describe an atomic and not molecular process.

Applicant therefore submits that the trademark "Molecular X-ray Fluorescence" is an arbitrary mark, as applied to applicant's class 9 goods, because no customer would

understand, or infer, or believe that x-ray fluorescence relates to a molecule and no customer would understand “Molecular X-ray Fluorescence”, the mark at issue in this appeal, as a widely known term. Zero results are retrieved upon searching the world-wide-web, internet, with the term "molecular x-ray fluorescence." Even the least sophisticated customer would understand that x-ray fluorescence relates to atoms and that “molecular x-ray fluorescence” is arbitrary and not descriptive. Applicant submits that the combination “molecular” and “x-ray fluorescence” creates a significant incongruity, because molecules do not undergo x-ray fluorescence. Therefore, even the least sophisticated customer would understand that “Molecular X-ray Fluorescence” is fanciful and meaningless. To date, Applicant has encountered no customers or prospective customers who understood “molecular x-ray fluorescence” to have any meaning. In fact, the least sophisticated customers have accepted “molecular x-ray fluorescence” as meaningless terms, while more sophisticated customers have congratulated Applicant on selecting the intrinsically meaningless term “molecular x-ray fluorescence.”

CONCLUSION

For the foregoing reasons, it is respectfully submitted the refusal to register applicant’s MFRF mark for the class goods set forth in this application, under the provisions of §2(e) of the Trademark Act, 15 U.S.C. §1052(e), was not proper and should be reversed.

Caldera Pharmaceuticals, Inc.

Respectfully Submitted,

By 

Benjamin Warner

Title: President

Date: October 14, 2012